

**REMARKS**

In the Office Action dated December 9, 2005, the Examiner rejected claims 1-6 and 26 under 35 U.S.C. § 102(b) as being anticipated by *Yanagawa et al.* (U.S. Patent No. 6,745,252)<sup>1</sup>. Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Yanagawa et al.* in view of *Humpleman et al.* (U.S. Patent No. 6,288,716). Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Takahashi et al.* (U.S. Patent No. 5,887,193). Claims 10-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Takahashi et al.* in further view of *Shigenobu* (JP 10-075424A).<sup>2</sup> Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Nonaka* (EP 0 955 635 A1). Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Maeda et al.* (U.S. Patent No. 5,559,780). Claims 16 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Kori et al.* (EP 0 716 545 A2). Claims 20, 21, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Kori et al.* in further view of *Takahashi et al.* Claims 22 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Kori et al.* in further view of *Shigenobu*. Claim 25 was rejected under 35

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<sup>1</sup> Please note that U.S. Patent No. 6,745,252 was published on June 1, 2004 and therefore does not qualify as 102(b) prior art with respect to Applicants' present application, which was filed on November 24, 2000. However, based on the January 11, 2000 date of national phase entry into the U.S., U.S. Patent No. 6,745,252 does qualify as 102(e) prior art.

<sup>2</sup> As indicated in our last response, Applicants would like to note that the *Shigenobu* reference has not been listed on a PTO-892. Applicants respectfully request that the Examiner list the *Shigenobu* reference on a PTO-892 in his next reply.

U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Kori et al.* in further view of *Nonaka*. Claims 17 and 19<sup>3</sup> were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Kori et al.* in further view of *Kimura* (JP 10-187380A). Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Kori et al.* in further view of *Kimura* in still further view of *Humpleman*.

By this Amendment, Applicants amend claims 1 and 16. As such, with entry of this Amendment, claims 1-27 remain pending in this application.

**Rejection of claims 1-6 and 26 under 35 U.S.C. § 102(b)**

In the Office Action dated December 9, 2005, the Examiner rejected claims 1-6 and 26 under 35 U.S.C. § 102(b) as being anticipated by *Yanagawa et al.* (U.S. Patent No. 6,745,252). Applicants respectfully traverse this rejection because *Yanagawa et al.* fails to disclose each and every claim recitation. Moreover, the Examiner has failed to address each of the claimed recitations as presented in independent claims 1 and 26. In particular, independent claims 1 and 26 recite more than a “producing means for producing an operation screen” as set forth in the Examiner’s rejection. (*Office Action*, page 3.) Independent claim 1 recites a recording and/or reproduction apparatus comprising, *inter alia*:

producing means for producing information for an operation screen including an area for displaying data stored in said storage medium and corresponding to said recording and/or reproduction means;

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<sup>3</sup> Although the Examiner did not include claim 19 in the rejection header along with claim 17, it appears from the placement of the text relating to the rejection of claim 19 in the body of the Office Action that it was meant to be included.

and independent claim 26 recites a similar recitation in a method form. Further, neither independent claim 1 or 26, as presented, recite a “storage means for storing operation screen information corresponding to said recording and/or reproduction means” as stated by the Examiner. (*Office Action*, page 3.)

Regardless of the omission, *Yanagawa et al.* fails to teach, at a minimum, the above recitation. Instead, as understood by Applicants, *Yanagawa et al.* discloses a device and a controller that controls the device through the use of a display screen. (See e.g., *Yanagawa et al.*, 2:46-54.) *Yanagawa et al.* also discloses wherein the information and objects that comprise the display screen are stored in a function information table 8 located in the device. (See e.g., *Yanagawa et al.*, 7:25-30.) However, *Yanagawa et al.* discloses that the device simply presents the data within the function information table 8 upon a request by the controller, which in turn creates the display screen. (See e.g., *Yanagawa et al.*, 9:5-8 and 10:62-67.) Therefore, because the device of *Yanagawa et al.* simply sends the data of the function information table, it does not have the capability to produce display information for an operation screen including an area for displaying data stored in a storage medium as claimed.

Dependent claims 2-6 are also allowable at least for the reasons set forth above in connection with independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 2-6 under 35 U.S.C. § 102(b) and the timely allowance of these claims.

**Rejection of claims 7-25, and 27 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 7-25 and 27 under 35 U.S.C. § 103(a) because the prior art cited by the Examiner does not establish a *prima facie* case of obviousness. The prior art reference (or references when combined) do not teach or suggest all the claim elements. See M.P.E.P. § 2143.03.

For example, independent claim 16 recites a recording and/or reproduction apparatus including, for example:

discrimination means operable for discriminating a type of the external apparatus based on the transmission request information when transmission request information for requesting transmission of data is received from the external apparatus through said communication means;

and independent claim 27 also recites a similar recitation in a method form.

The Examiner admits that *Yanagawa et al.* does not disclose the claimed discrimination means. (See *Office Action*, p. 9.) In an attempt to address these shortcomings, the Examiner relies on *Kori*. However, *Kori* also fails to disclose the claimed discrimination means. The Examiner asserts that *Kori* discloses “an apparatus having a control means for converting the image stored in a medium to a format [that] can be displayed by the display apparatus.” (*Office Action*, page 9.) However, *Kori* only converts the format based on “(1) when an operator decides that the aspect ratio for the video picture is to be converted and turns on the aspect-conversion switch 6; and (2) when the microcomputer 5 determines that the aspect ratios of the input video signal and the television (not shown) do not correspond.” (*Kori*, 5:22-27.) Therefore, *Kori* does not disclose a “discrimination means operable for discriminating a type of the

external apparatus based on the transmission request information...,” as recited in claim 16, and similarly recited in claim 27.

In conclusion, *Yanagawa et al.* and *Kori*, whether taken alone or in combination, fail to teach or suggest all of the elements of claims 16 and 27. The Examiner has therefore not met an essential criteria for establishing a *prima facie* case of obviousness, wherein “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See M.P.E.P. § § 2142, 2143, and 2143.03. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Dependent claims 17-25 are also allowable at least for the reasons set forth above in connection with independent claim 16. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 17-25 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Moreover, Applicants respectfully traverse the Examiner’s rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over *Yanagawa et al.* in view of *Humpleman et al.*; the rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Takahashi et al.*; the rejection of claims 10-12 under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Takahashi et al.* in further view of *Shigenobu*; the rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Nonaka*; and the rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Yanagawa et al.* in view of *Maeda et al.* None of the references *Humpleman et al.*, *Takahashi et al.*, *Shigenobu*, *Nonaka*, or *Maeda et al.* teach or suggest the claimed

"producing means," nor does the Examiner rely on these references for such teachings.

Claims 7-15 are thus allowable due to their dependency from claim 1.

**Conclusion**


In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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